

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/21/2011 has been entered.

Status of Claims

Claims 1-18, 20-56, 58-61, and 64-75 are pending in the instant application. Claims 15-17, 20-41, 58-60, 64-66, and 68 are withdrawn from consideration. Claims 1-14, 18, 42-56, 61, 67, and 69-75 are under examination.

Duty of Disclosure

Applicants are reminded of their duty to disclose all pertinent information regarding patentability of the instant claims (see MPEP 2001.06). The examiner respectfully requests that applicants provide the sources of the proviso compounds listed in claim 1 (i.e. **identification of the specific references which contain these species and their specific locations within said references**).

Previous Objections/Rejections

Any rejections or objections stated of record in the office action mailed on 9/21/2010 that are not explicitly addressed herein below, are hereby withdrawn in light of applicant's arguments and/or amendments filed 4/21/2011.

New Objections and Rejections

Claim Objections

In claim 1, "ringsystem" should be rewritten as "ring system". Thus, the claim and dependent claims are objected to.

Claim 5 is objected to because of the recitation "Phtalimidiny!". The correct spelling should be "*Phthalimidiny!*".

Claims 56 and 69 recite duplicate heteroaryls for substituent W^b (see 2-,3-, and 4-linked pyridines for example). Correction is required.

Claim Rejections - 35 USC § 112 (2nd Paragraph)

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 42-55, 61, 72, and 73 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The recitation:

Art Unit: 1624

with the proviso that the compound is not I[[[7,7-dimethyl-2-oxobicyclo[2.2.1]hept-1-yl)methyl]sulfonyl]-4-(2-oxo-2 H-3,1-benzoxazin-1(4H)-yl)-piperidine

is now considered indefinite and lacks sufficient antecedent basis in regard to the amended aforementioned claims. The proviso compound has the limitation wherein W = a substituted cycloaliphatic radical bonded *via a methylene group*. The instant claims now read that W may be a cycloaliphatic radical *which cannot* be bonded via a mono substituted alkylene group. Thus, the claims and claims which depend on them which do not rectify the issue are considered indefinite. The examiner recommends that the claims are appropriately amended to obviate the rejection (e.g. the cycloaliphatic radical recitation is altered or that the proviso is removed).

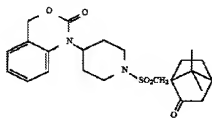
Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4, 6-13, 18, 42-55, 61, 70, 72, and 73 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bock *et al.* (US Patent 5,665,719-mentioned in international search report). Bock *et al.* teach the following compound (see col. 30, example 10, and previous office actions):

Art Unit: 1624



wherein $R^{1-9} = H$ and $W =$ a substituted cycloaliphatic radical bonded via a methylene group. The document further mentions that this compound may be used to treat hypertension (see col. 270, claim 16); a common food-intake related disorder.

The aforementioned claims may encompass an analogous compound with the exception that the substituted cycloaliphatic radical is attached directly to the $-SO_2$ moiety (i.e. methylene is absent). However, the document teaches that the methylene spacer may be present or *absent* as in the instant claims (see abstract, wherein m is selected from 0 or 1). Thus, the skilled artisan would have been motivated to select from the finite number of possible solutions disclosed in the document and expect a compound with similar biological activity. As Applicants have conveniently pointed out, that for a claimed invention to be obvious, the possible modifications of the prior art must be finite, see *Rolls-Royce PLC v. United Technologies Corp.*, 95 USPQ2d 1097 (Fed. Cir. 2010).

Conclusion

Claims 1-4, 6-13, 18, 42-55, 61, 70, 72, and 73 are rejected. Claims 5, 14, 56, 67, 69, 71, 74, and 75 are objected to. A potential reasons for allowance

Art Unit: 1624

(without consideration of the proviso compounds) for the objected claims was cited in the prior office action.

1. This is a RCE of applicant's earlier Application No. 10/566404. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP

§ 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BRIAN MCDOWELL whose telephone number is (571)270-5755. The examiner can normally be reached on Monday-Thursday 8:30-5:00.

Art Unit: 1624

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. James O. Wilson can be reached 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/B. M./
Examiner, Art Unit 1624

**/JAMES O. WILSON/
Supervisory Patent Examiner, Art Unit 1624**